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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,248	06/04/2001	Yoshiya Isono	113197-004	8139
24573	7590	07/26/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC PO BOX 1135 CHICAGO, IL 60690-1135			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/786,248

Applicant(s)

ISONO ET AL.

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25 and 39-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 39-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This action is in response to Amendment filed June 15, 2005. Claims 25 and 50 have been amended and claims 19-24 and 26-38 have been cancelled as requested by the applicant.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 39-48 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Aiki (US 4,803,361).

Regarding claims 25 and 50, Aiki discloses an optical module comprising optical fibers (16; col. 5 line 42) protruding portion and tips (Fig. 3); an optical connector section (25) connecting to an outside optical connector the optical connector section having inserted there into and secure the optical fibers (Fig. 3); a light emitting element (15); a light receiving element (18); two mounts (39 for receiving element and 12 for emitting element) on which are mounted the light emitting and light receiving elements (Fig. 3); a package (1) comprising a positioning structure comprising walls (11); the package accommodates the mounts and fixes the optical connector section (Fig. 3), wherein the two mounts are separately formed from the package (Fig.

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3; col. 5 lines 10-50); the optical fibers protrude to the inside of the package (Fig. 3); the walls of the positioning structure directly contact the side faces of the mounts (Fig. 11, shows wall 11 supports the mounts for the emitting and receiving elements); wherein each of the tips of the optical fibers being arranged so as to oppose one of the light emitting face of the optical elements and a light receiving face of the optical elements (Fig. 3); the positioning structure positions the mounts at predetermined positions so that the light emitting face or the light receiving face opposed at lest one of the tips of the optical fibers (Fig. 11); and the positions of the two mounts differ in the longitudinal direction of the optical fibers (Fig. 3).

Regarding claims 39-44, Aiki discloses the positioning structure comprises protrusion for positioning which protrude inwardly from inner wall of the package (Fig. 5; shows wall, 11, protrudes upward which is considered to be inwardly). Aiki further discloses the positioning structure (11) comprises a side face of the positioning stand provided so as to touch the side face of the mounts which the optical elements are mounted on and thereby position the mount (Fig. 5). Aiki further disclose a positioning stand (13) positioning the protruding portions of the optical fibers (Fig. 5).

Regarding claim 45, Aiki discloses a second wall formed so as to position at least one mount in a direction at generally a right angle to the longitudinal axis of the optical fiber (Fig. 5). Fig. 5 shows that the wall (11) has walls that extend to the left and right (longitudinal direction) and up and down (orthogonal to the longitudinal direction).

Regarding claim 46, Aiki discloses at least one of the mounts is positioned by the positioning structure such that the respective light emitting or light receiving element is longitudinally aligned in with the protruding portion of one of the optical fibers (Fig. 3).

Regarding claim 47, Aiki discloses at least one of the mounts is positioned by the positioning structure such that the respective light emitting or light receiving element is angled to the longitudinal direction with the protruding portion of one of the optical fibers (Fig. 6). Fig. 6 shows that light receiving element (18) is at an angle to the end (30) of the optical fiber.

Regarding claim 48, Aiki discloses at least one wall does not protrude inwardly in the package (Fig. 5).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aiki (US 4,803,361).

Aiki teaches the invention as claimed but lacks reference to the wall comprising an inner wall of the package. The Aiki reference suggest using the inner wall of the package to support mounts as shown in Fig. 3 when the inner wall (7) supports the mount (25) for the optical fiber. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Aiki reference support the light emitting and light receiving element mounts with the

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inner wall of the package as suggested by Aiki for the purpose of more easily manufacturing the apparatus by being able to create the package and the mount supporting walls in a single mold.

### *Response to Arguments*

Applicant's arguments, see Amendment, filed June 15, 2005, with respect to the rejection(s) of claim(s) 25 and 39-50 under Sato have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration of the newly amended claim limitations, a new ground(s) of rejection is made in view of Aiki (US 4,803,361). Applicant amended the claim language to include limitations, which the examiner stated in the preceding telephone interview would overcome the previously cited prior art.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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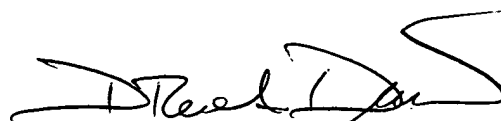
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP



**DREW A. DUNN**  
**SUPERVISORY PATENT EXAMINER**